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NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			PLUMMER, ELIZABETH A	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/562,199	<b>Applicant(s)</b> STRASSO, PASQUALE
	<b>Examiner</b> ELIZABETH A. PLUMMER	<b>Art Unit</b> 3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 04 January 2010.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 35-76 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 35-76 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)

Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)

Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicant's amendments and arguments received 01/04/2010 have been entered and considered. Claims 1-34 have been canceled. Claims 69-76 have been added. An examination of pending claims 1-76 is herein presented.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 35-41, 49-57 and 69-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As explained before, in claim 35 the language between the preamble and portions of the body of the claim are inconsistent. For example, the preamble of the claim 35 sets for the subcombination "an apparatus ... suitable for covering a water tank"; however, line 5 of the claim recites the combination of an apparatus with a tank which sets forth a positive relationship between the tank and the apparatus and thus appears to claim a combination. Clarification is required. During the prior office action dated 06/20/2009, it was assumed that the claim was directed toward a combination. However, as the applicant as amended the claim to read "being configurable as to keep said tank...", it appears that applicant was instead claiming the broader subcombination. In addition, claim 76 contains the phrase "and/or" which is inherently indefinite.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 35-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Garrett (US Patent 6,926,241).

a. Regarding claim 35, Garrett discloses an apparatus (Fig. 21,22; abstract) comprising a covering arrangement (tarp – column 22, lines 15-19) suitable for covering a water tank which can be mounted onto an external portion of a building (column 10, lines 65-68; column 11, lines 1-3), said covering arrangement being made in the shape of an architectural component of the building (tarp can conform to any shape), wherein said apparatus further comprises an angular positng device (Fig. 1,21,22) being configurable as to keep said tank in a substantially vertical position.

b. Regarding claim 36, the water tank is a component of a solar panel system (column 11, lines 103).

- c. Regarding claims 37 and 44, said angular positioning device comprises a seat (Fig. 21,22) arranged for housing said tank therein, and an anchoring element (510,512) for anchoring to said external portion.
- d. Regarding claims 38 and 45, said seat and said anchoring element are disposed in opposite portions (top, bottom) of a positioning shell element (frame).
- e. Regarding claims 39 and 46, said seat is disposed in a first positioning shell element (top frame 518).
- f. Regarding claims 40 and 47, said anchoring element is obtained in a second positioning shell element (bottom frame) hinged (via 520) on said first positioning shell element.
- g. Regarding claims 41 and 48, said seat is shaped such that a longitudinal axis of a tank can be arranged vertically by rotating said first positioning shell element in relation to said second positioning shell element (Fig. 21,22).
- h. Regarding claim 42, Garrett discloses a covering arrangement (tarp column 22, lines 15-19) suitable for covering a component of an air-conditioning system that can be mounted onto an external portion of a building, said covering arrangement being made in the shape of an architectural component of the building (as a tarp can take any shape).
- i. Regarding claim 43, an angular positioning device (frames with hinge) keep said component in a substantially vertical position (Fig. 21,22).
- j. Regarding claim 49, said external portion comprises a roof (Fig. 21,22).

5. Claims 35, 37, 42-44, 49-51, 53, and 69-75 are rejected under 35 U.S.C. 102(b) as being anticipated by *Wilhelmsen* (US Patent 6,093,098).

- a. Regarding claim 35, *Wilhelmsen* discloses an apparatus comprising a covering arrangement (10) suitable for covering a water tank which can be mounted onto an external portion of a building, said covering arrangement being made in the shape of an architectural component (chimney) of the building, and an angular position device (38) being configurable so as to be able to keep a tank in substantially vertical position.
- b. Regarding claims 37 and 44, the angular positioning device comprises a seat arranged for housing, or capable of housing, a tank therein, and anchoring element (14) for anchoring to said external portion (Fig. 2).
- c. Regarding claim 42, *Wilhelmsen* discloses an apparatus comprising a covering arrangement suitable for covering a component of an air-conditioning system which can be mounted onto an external portion of a building (Fig. 1,2), said covering arrangement being made in the shape of an architectural component of the building (Fig. 2).
- d. Regarding claim 43, an angular positioning device (28) can keep said component in a substantially vertical position (Fig. 20).
- e. Regarding claim 49, said external portion comprises a roof (Fig. 1,2).
- f. Regarding claim 50, said component has a shape of a chimney cap (Fig. 1,2).

- g. Regarding claim 51, said covering arrangement comprises a wall arrangement.
- h. Regarding claim 53, said wall arrangement furthermore comprises a grille (Fig. 2).
- i. Regarding claims 69 and 72, said covering arrangement comprises at least one structural side wall dimensioned to be able to hide a water tank from view (Fig. 1,2).
- j. Regarding claims 70 and 74, said covering element comprises a top element (Fig. 1,2), said top element in combination with said at least one side wall forming an interior space capable of enclosing a water tank.
- k. Regarding claims 71 and 75, the covering arrangement is harmonized with the building (Fig. 1,2).
- l. Regarding claim 72, said at least one side wall comprises a plurality of side walls (Fig. 1,2).

***Claim Rejections - 35 USC § 103***

- 6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 7. Claims 50-57 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (US Patent 6,926,241).

- a. Regarding claim 50-55, Garret discloses the invention as claimed except for how the covering decoratively appears. However, it would have been a matter of obvious design choice to form the architectural component as any type of decorative design, including a chimney cap, skylight, attic skylight, veranda, balcony, column, arch, wall arrangement, wall arrangement with a window, wall arrangement with a grille, wall arrangement made of bricks or wall arrangement made of panels, as such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ 47 (CCPA 1966).
- b. Regarding claims 56-57, Garrett discloses the invention as claimed except for what material comprises the architectural component. However, it would have been a matter of obvious design choice to form panel sections out of a material that resists atmospheric agents such as glass fiber, A.B.S., polycarbonate, polystyrene or sheet metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.
- c. Regarding claim 76, Garrett discloses a covering means (tarp) for covering a functional, non-architectural component mounted onto an external portion of a building in such a way that the component is substantially hidden from view (under the tarp) and means for adjustably maintaining said functional,

non-architectural component in a substantially vertical position (fig. 21,22).

Garret does not disclose a means for architecturally and aesthetically harmonizing the covering means with the external portion of the building or the architectural system of the building. However, it would have been a matter of obvious design choice to form the architectural component as any type of decorative design, as such a change would be purely aesthetic. Furthermore, such decorative designs are well known in the art.

8. Claims 58-60 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Solomon (US Patent 5,989,656) in view of Blue Hill Avenue.

m. Regarding claim 58, Solomon discloses a method of forming an image (floral image), disposing the image on a layer element (net) and applying said layer element onto a supporting surface element (frame of the utility box or air conditioner) surrounding a functional non-architectural element (utility box, air conditioner), the functional non-architectural element being disposed on the building. Solomon does not disclose that the image can be of a selected part of a building. However, it is well known in the art that one type of decorative image that can be used is an image of a selected part of a building. For example, Blue Hill Avenue discloses a method comprising forming an image of a selected part of a building (window), disposing the image on a layer element (board), and applying said layer element onto a supporting surface element surrounding a functional element, the functional element being disposed on the building (See figs.) It would have been obvious to one of ordinary skill in the art to modify

Soloman to use an image of a selected part of a building, such as taught by Blue Hill Avenue, in order to create a different decorative effect.

n. Regarding claim 59, the supporting surface element is part of a covering arrangement enclosing said functional non-architectural element.

o. Regarding claim 60, the supporting surface element is comprised in an external surface (frame of the utility box or air conditioner) of said functional non-architectural element.

p. Regarding claim 68, the functional non-architectural element comprises a component of an air-conditioning system.

9. Claims 58-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew (US Patent 3,742,659) in view of Cherkas et al. (US Patent 5,858,494).

a. Regarding claim 58, Drew discloses a method for a building wherein there is a functional non-architectural element with a cover (abstract; Fig. 1). Drew does not disclose that element is disguised by the method of forming an image of a selected part of a building, disposing the image onto a layer element and then applying said layer element onto a supporting element surrounding a functional non-architectural element. However, it is notoriously well known in the art that different items can be decorated. It is also notoriously well known in the art that a method of decorating an object can comprise reproducing a selected part of an original to get an image therefrom, disposing the image onto a layer element and then applying the layer element onto a support surface element. For example, Cherkas et al. discloses the method of decorating an object (lure) can comprise

reproducing, or forming, a selected part of an original (fish) to get an image therefrom, disposing the image onto a layer element and then applying the layer element onto a support surface element (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Drew to use the method of creating decorations, wherein of the decorating of an object can comprise reproducing, or forming, a selected part of an original to get an image therefrom, disposing the image onto a layer element and then applying the layer element onto a support surface element, such as taught by Cherkas et al., in order to better disguise and blend in the architectural element.

- b. Regarding claim 59, the supporting surface is part of a covering arrangement enclosing said functional non-architectural element (Fig. 1).
- c. Regarding claim 60, the supporting surface element is on an external surface of the functional non-architectural element (Fig. 1).
- d. Regarding claim 61, Cherkas et al. further discloses the image can be obtained using a photographic device (camera).
- e. Regarding claim 62, the image is transferred onto a supporting film, so as to form a covering layer (abstract).
- f. Regarding claim 63, applying the covering layer can comprise winding the layer element around the covering arrange housing said functional non-architectural element.
- g. Regarding claim 64, applying comprises inherently mutually engaging opposite edge of the layer element.

h. Regarding claim 65, while Drew in view of Cherkas et al. is silent as to the shape of the covering arrangement, it would have been a matter of obvious design choice to form the architectural component as any type of decorative design, including a chimney cap, skylight, attic skylight, veranda, balcony, column, arch, or wall arrangement, as such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Dailey*, 149 USPQ 47 (CCPA 1966).

i. Regarding claim 68, the functional non-architectural element can be an air-conditioning system (column 1, lines 15-68).

10. Claims 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew (US Patent 3,742,659) in view of Cherkas et al. (US Patent 5,858,494 as applied to claim 58 above, and further in view of Garrett (US Patent 6,926,241).

q. Regarding claims 66-67, Drew in view of Cherkas et al. discloses equipment can comprise the functional non-architectural element (column 1, lines 7-10). While Drew does not specifically state that the equipment can be a water tank in a solar panel system or an air-conditioning system, it is notoriously well known in the art that a type of equipment to be mounted and covered on a roof can include a water tank with a solar panel system. For example, Garrett discloses a water tank in a solar panel system (paragraph 83) can be housed in an apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Drew in view of Cherkas et al. to include a

water tank in a solar panel system, such as taught by Garrett, in order to supply hot water to a building.

***Response to Arguments***

11. Applicant's arguments filed 01/04/2010 have been fully considered but they are not persuasive. Regarding the 112 rejection, it is not clear for the claim amendments or applicant's response in the arguments what the applicant is trying to claim. As such, the 112 rejection has been maintained concerning the confusion over a combination vs. subcombination. However, in light of how the amendments appear to be trying to make certain limitations in claim 35 functional, it is assumed that the applicant had actually intended to claim a broader subcombination. As such, additional rejections have been cited that more closely read on a subcombination. Regarding Garret, the original rejection has been maintained, but for clarity purposes elements are now being referred to by page and line number rather than paragraph. Applicant is correct that the tarp is the covering arrangement. Note that while applicant says that a tarp is not suitable to cover a water tank, this is simply not true. A tarp is capable of being placed not only over a water tank or an air conditioning system, but also over almost anything. In addition, tarps are malleable, and so they can be formed to take any shape. Note that claims 35 and 42 do not require that that covering match the exterior of the building, but rather that a certain shape be found. Furthermore, even if the tarp is laid flat, architectural components, such as walls or windows, can have a flat shape. Regarding claim 50, applicant argues that the tarp is not capable of harmonizing the design, but note that this limitation is not found in claim 50, but only new claims 71, 75 and 76. This

new limitation has been addressed by the new rejection above. Furthermore, in support of making any type of decorative design, addition references have been citing showing covers with harmonization. In response to applicant's argument that Cherkas is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Cherkas is related to the problem of reproducing, or forming, images using a camera. It is not the fishing lures that are incorporated by Cherkas, but rather the method or technique of reproducing and transferring images.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH A. PLUMMER whose telephone number is (571)272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeanette E Chapman/

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Primary Examiner, Art Unit 3633

/E. A. P./

Examiner, Art Unit 3635